

**REMARKS/ARGUMENTS**

Reconsideration and allowance of all the claims of record are respectfully requested.

Claims 1-93 have been cancelled, without prejudice, in order to simplify issues and expedite prosecution of this case. For the reasons set forth below, it is respectfully submitted that new claims 94-132 patentably distinguish over Yamauchi et al. (U.S. Patent No. 6,020,982) (hereinafter, Yamauchi), the sole reference applied by the Examiner (as did previously pending claims 1-93).

Claims 1-93 were rejected under 35 U.S.C. §102(e) as being anticipated by, or under 35 U.S.C. §103 as being unpatentable over Yamauchi. The applicants submit that the Yamauchi patent fails to disclose or even remotely suggest the claimed invention as defined in each of independent claims 94, 122 and 125 and the claims dependent therefrom. The claims of record define a unique portable, palm-sized digital data transfer and repository apparatus and methodology which is not disclosed or suggested by Yamauchi.

Turning first to the Examiner's "anticipation" rejection based upon Yamauchi, in order for the Examiner to make a proper case of anticipation, it is necessary that each and every claim limitation be disclosed in Yamauchi, either expressly or under principles of inherency. See, for example, Kalman v. Kimberly-Clark Corp., 218 USPQ 701, 709 (Fed. Cir. 1983). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference may only be deemed to anticipate a claim

if the missing element "is necessarily present in the thing described in the reference."

*Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749(Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599(Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

The applicants submit that Yamauchi lacks various features required by each of the claims of record and is a fundamentally different type of device than that which is defined by the claimed invention. Yamauchi does not disclose or suggest a palm-sized, portable digital data transfer and repository device having the claimed elements embodied in a hand-held housing its own display.

Yamauchi's "image data processing apparatus/editing machine" has a fundamentally different purpose than the claimed invention. The Yamauchi apparatus is a specialized image editing computer, intended for stationary use, where convenience of size and portability is of no importance. Although the Examiner has characterized the editing device as shown in Figure 62 as being portable, Yamauchi expressly states that "[t]his editing machine 600 is of a stationary type." Col. 37, lines 45, 46. In contrast, the claimed invention embodies a convenient, highly portable tool for users of digital cameras and for photography buffs who desire to, for example, transfer digital photographs stored in the user's PC to a portable repository device which can be easily transported and operated while held in the user's palm.

Yamauchi's lack of the claimed portability-related features (e.g., most of the recited components are required to be embodied in the claimed hand-held housing) is evident from its description of Figure 62. The editing device of Figure 62 is described as a subsystem of a larger apparatus. The box by itself (referred to as similar in size to a VCR) appears to be incapable of performing **any** function on its own. For it to perform any task, it first must be operatively coupled to a separate keyboard, a monitor, an external hard disk, etc.. For example, note that Yamauchi expressly discloses with respect to Figure 62 that:

at its rear side which is not shown in the drawing, there are multiple connectors for connecting external devices, such as monitors 801a, 801b, 801c..., disc recording unit 802...." Col. 37, lines 47-50.

It is therefore apparent that the editing machine in Figure 62 has no visible display (other than LED's). The display text referred to by the examiner could not be displayed on the editing machine as shown in the figure. One must assume that a separate display monitor must be attached before text messages can be viewed.

Further, column 37, line 53 indicates that the editing machine "has almost no operation switch or key". Again, it relies on attaching a keyboard via a cable in order to have key input.

It is untenable to consider such a system as portable and having a housing embodying the claimed components.

Accordingly, for example, it is not seen where, Yamauchi discloses the claim 94 limitations such as "a housing of a size to be held in the palm of a user's hand and

including at least one port operable to receive digital camera picture image data and at least one port operable to couple said portable repository device to a user's computer and to receive digital picture image data from said user's computer." Further, Yamauchi does not disclose such a portable device having processing circuitry embodied in a hand-held housing, said "processing circuitry being operable to determine whether a request has been made to transfer picture image data from a user's computer to said mass storage device." Nor does Yamauchi disclose such a hand-held device having a display and "at least one user interface key embodied in said housing for controlling operations involving picture image data."

With such a hand-held device a digital photographer may select a portfolio of family photos stored on the user's computer, fly across the country, and conveniently transport the repository device and the digital photographs for editing and for viewing by family and friends.

Even if the Examiner were of the view that it is conceivable that the applied reference could be modified so as to result in the claimed invention, such a modification would not have been obvious within the meaning of 35 U.S.C. §103, unless the prior art suggests the desirability of such a modification. See In re Gordon, 773 F.2d 900 (Fed. Cir. 1984), and In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1 (Fed. Cir. 1983). Absent any such suggestion, the applicants can only conclude that any continued rejection based upon the applied reference must necessarily be grounded upon an improper hindsight reconstruction of the applicants' invention using the applicants own disclosure as a guide.

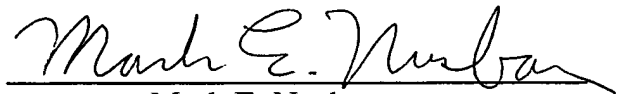
BATTAGLIA et al.  
Appl. No. 09/615,838  
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The Examiner has failed to present a *prima facie* case of unpatentability of the claimed invention. Unless such a case is presented, the applicants are entitled to the grant of a patent based upon the present application. See In re Oetiker, 24 U.S.P.Q. 2<sup>nd</sup> 1443 at 1444 (Fed. Cir. 1992).

In view of the foregoing, the applicants believe that all of the claims are in condition for allowance and action to that end is earnestly solicited. If any issues remain to be resolved, the Examiner is urged to contact applicants' attorney at the telephone number listed below.

Respectfully submitted,

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